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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,362	06/05/2002	Thomas R. Anthony	049846-5003	8127

7590 12/08/2003

EXAMINER
HENDRICKSON, STUART L

ART UNIT	PAPER NUMBER
1754	

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DATE MAILED: 12/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/362	Applicant(s) Anthony
	Examiner Nguyen	Group Art Unit 1754

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 10/14/03.

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-31 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-31 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3, 8, 9, 23-27, 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) The recitation of colors is potentially unclear, in view of colorblindness, etc. Note that the difference between claims 8 and 9 (26 and 27) is not entirely clear.

B) In claims 23 and 29, 'high' is subjective and unclear as to the adsorption. The specification does not shed light on what constitutes high.

Claims 23-27 and 29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Satoh et al. 4959201.

This is the same rejection as made previously, incorporated herein by reference.

Claims 23-27 and 29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Harlow book.

This is the same rejection as made previously, incorporated herein by reference.

Claims 23-27 and 29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Strong et al. 4124690.

This is the same rejection as made previously, incorporated herein by reference.

Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strong et al. '690, alone or taken with Wentorf, Jr. 3609818.

Strong teaches in columns 4-6 treating a Type 1b by annealing at elevated temperature and pressure in a press, resulting in a change of color. This differs from the claims only in not

reciting a pressure-transmitting pill encasing the diamond, however Strong teaches placing graphite around the diamond. This is deemed to render the use of a pill as obvious, in order to gain the benefits recited in column 4. Therefore, it is deemed that the diamond is inside a pill- especially after the pressing starts and compacts the graphite powder.

In so far as Strong does not teach or form a pill, or that the claims require the presence of a pill prior to insertion into the apparatus, Wentorf teaches in column 4 the use of talc (which contains MgO) or salt as a pressure-transmitting medium. Using talc in the process of Strong is an obvious expedient to attain uniform pressure on the diamond being treated and prevent inhomogeneous pressure and corresponding defects.

Concerning the various dependent claims, treating diamonds have a particular type, N content or platelets is an obvious expedient to make a more valuable material, as is repeating the treatment for improved effect.

Claims 1-16, 19-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon 3134739.

Cannon teaches in column 2-4 placing colored diamond and graphite filler into a press and treating under HP/HT, with a resulting change in color. As the diamonds are yellow, it appears they are Type 1A; if not, using the claimed type is an obvious expedient to treat an available diamond. Cannon does not describe the use of a pill, forming the graphite/diamond charge into a pill is an obvious expedient to avoid air pockets which would interfere with the pressure transmission or diffusion of the Al. Repeating the process is an obvious expedient to attain the desired effect. Column 6 line 72 teaches brown diamonds.

Applicant's arguments filed 10/14/03 have been fully considered but they are not persuasive.

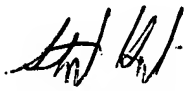
The argument that the process is different does not differentiate the product claims; as the color is the same, it appears the spectrum is the same too. There is not sufficient information on the spectrum to differentiate the pictures from the product claimed. Concerning Strong/Wentorf,

the claims do not require the color change argued- most claims are indefinite as to color and the ones which do specify yellow do not say how intense a yellow. The Declaration is not persuasive over Cannon, as the claims are open to using Al. What has been shown is that conditions described in the specification as being effective to change color do not work on brown diamonds. When Al is used, Cannon reports a color change. Therefore, Cannon changes color. The recitation of colors is unclear because the color is not firmly a result of one phenomenon. Thus, arguments to H centers is not persuasive.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (703) 308-2539.



Stuart Hendrickson
examiner Art Unit 1754